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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,694	01/05/2004	Xiao Quan Zhang		1693

39948 7590 04/01/2009
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EXAMINER

FORD, GRANT M

ART UNIT	PAPER NUMBER
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2441

MAIL DATE	DELIVERY MODE
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04/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,694	Applicant(s) ZHANG ET AL.	
	Examiner GRANT FORD	Art Unit 2441	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/5/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.
2. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450
3. Claims 1 and 12 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.
4. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Note the format of the claims in the patent(s) cited.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure corresponding to the numerous “means for” limitations present in independent claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Regarding instant claim 11, the claim depends from independent claim 1 and functions to remove limitations present in independent claim 1. For purposes of examination, the Examiner has grouped independent claim 1 and dependent claim 11 together.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. As to claims 1-11, the claimed invention is directed to non-statutory subject matter. Regarding claims 1-11, the instant claims recite purely software means. As such, claims 1-11 are directed to non-statutory subject matter under 35 U.S.C. 101.

10. Regarding dependent claims 12-15, the claims fail to establish a proper statutory category of invention as specified by 35 U.S.C. 101. For example, the method claim of dependent claim 12 functions to recite both a process and apparatus by virtue of its dependency on the system claim of independent claim 1. For purposes of examination, the Examiner has examined claim 12 as corresponding to the method of using the system of independent claim 1, wherein the system is naturally inherent in the use of the method of claim 12.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding independent claim 1, it is unclear what, if any, structure from the instant specification is associated with the “means for” language present in each limitation of the claim (see MPEP 2181(I)). In the event that all “means for” language is directed to the same structure from the instant specification, the claim fails to meet the limitation of 35 U.S.C. 112 second paragraph as a single means claim (MPEP 2164.08(a)).

13. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 12, the claim limitations “optionally containing” and “optionally inserting” are indefinite as it is unclear as to whether Applicants intend to claim said containing and inserting. For purposes of examination, the Examiner has not given the phrases “optionally containing” and “optionally inserting” patentable weight.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 4, 6, and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamakura et al. (US 6,076,101), hereinafter referred to as Kamakura.

a. As per claims 1 and 11, Kamakura discloses a system of using anti-spam points for email processing comprising:

at least the included means in combination of:

means for allowing said email users to register to become said system's registered email users, means for automatically or manually inserting said fingerprint keys into said registered email users' email messages, means for owners of email servers to register and establish accounts for their servers to earn and redeem said anti-spam points, means for maintaining one or more databases containing registered email user profiles, and means for extracting from an email message its sender's profile for comparison with the record in said databases (Figures 5 and 9-10, Abstract, Col. 5 lines 24-48, Col. 6 lines 20-25, Col. 19 lines 19-53).

b. As per claim 4, Kamakura discloses wherein said amount of anti-spam points is variably issued in accordance with said sender's category and registration process (Col. 5 lines 20-48).

c. As per claim 6, Kamakura discloses wherein said databases of email users include a subset or a super set of fields corresponding to said email users (figure 9).

d. As per claim 8, Kamakura discloses wherein said sender's email is held in said recipient's email server, or in said recipient's own storage media as specified by said recipient's email client (Abstract, Figure 1, Col. 2 line 60 through Col. 3 line 20).

e. As per claim 9, Kamakura discloses wherein said email recipients are allowed to redeem their earned anti-spam points for money, goods, or services when said anti-spam points in their accounts have reached a threshold value, or when the monetary value associated with said anti-spam points has reached a threshold value, or when said recipients make a request for redemption (Figure 10, Abstract, Col. 19 lines 19-53).

f. As per claim 10, Kamakura discloses wherein the monetary value of the purchase of a number of paid anti-spam points is equivalent to or different from the monetary value of the redemption of those same numbers of anti-spam points (Col. 5 line 49 through Col. 6 line 11, Col. 9 lines 43-53, Col. 10 lines 8-24).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamakura in view of Malcom (US 7,433,924).

a. As per claim 2, Kamakura discloses the invention substantially as claimed above. However, Kamakura fails to explicitly disclose substituting said recipients email server with a recipient's email client software or a plug-in to any available email client software.

Malcom teaches substituting a mail server-level filter with a client side filtering implementation (Col. 3 lines 3-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the use of a client-side filter with the prior art of Kamakura. One of ordinary skill in the art would have done so for the purpose of permitting a user to specify filtering data in order to better suit the user's filtering needs (Col. 3 lines 19-29).

18. Claims 3, 5, 7, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamakura in view of Moskowitz et al. (US 7,280,982), hereinafter referred to as Moskowitz.

a. As per claim 3, Kamakura discloses the invention substantially as claimed above. However, Kamakura fails to explicitly disclose the use of a telephone or facsimile machine for registration.

Moskowitz teaches the use of a telephone system for use with registration in a fee-based messaging environment (Abstract, Col 2 lines 25-37 and 51-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the use of a telephone system with the prior art of Kamakura. One of ordinary skill in the art would have done so for the purpose of providing a fee-based messaging system which provides for messaging by at least e-mail, telephone, facsimile, or pager (Abstract, Col 2 lines 25-37 and 51-64)

b. As per claim 5, Kamakura discloses the invention substantially as claimed above. Kamakura additionally discloses wherein said fingerprint key is either revealed to, or concealed from the email recipient (Col. 6 lines 33-67). However, Kamakura fails to explicitly disclose wherein said fingerprint key is valid for a limited time duration.

Moskowitz teaches wherein said fingerprint key is valid for a limited time duration and a new fingerprint key is generated for said registered email users when the current fingerprint key expires (Col 3 lines 13-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of fingerprint keys have a limited duration with the prior art of Kamakura. One of ordinary skill in the art would have done so for the purpose of providing a fee-based messaging system wherein a fee is directly associated with a time period assigned for a given message (Col 3 lines 50-56).

c. As per claim 7, Kamakura discloses the invention substantially as claimed above. However, Kamakura fails to explicitly disclose , wherein said encoded string is

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plain text, or an output of said required information from any kind of encoding algorithm that is possibly used by one skilled in the art.

Moskowitz teaches wherein said encoded string is plain text, or an output of said required information from any kind of encoding algorithm that is possibly used by one skilled in the art (Col. 2 lines 38-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of an encoding algorithm for outputting required information. One of ordinary skill in the art would have done so for the purpose of providing security for messages containing private information (Col 2 lines 38-50).

d. As per claim 12, Kamakura discloses the invention substantially as claimed above. Kamakura additionally discloses a) recipient's email server or client receiving an email from a sender, said email including an address field containing said sender's email address, a message field optionally containing said sender's fingerprint key issued by said system, optionally containing the type and number of anti-spam point, and optionally containing said sender's threshold value or range for paying out anti-spam points (Col. 6 lines 20-25);

b) recipient's email server or client encoding said sender's email address, fingerprint key, threshold value or range for paying out anti-spam points, the type and number of anti-spam points born by said email, said recipient's email address, recipient's threshold value or range for charging paid anti-spam points, or any combination thereof (Col. 6 lines 20-25);

c) recipient's email server sending said encoded information to said system for authentication (Col. 6 lines 20-25 and 44-47); and

adding appropriate quantities and appropriate types of anti-spam points to recipient's record (Figure 5, Col. 5 lines 24-48). However, the prior art of Kamakura fails to explicitly disclose verifying if said sender's email address is not on record, or said sender's fingerprint key does not match that of said record, or said sender's anti-spam points are insufficient.

Moskowitz teaches d) if said sender's email address is not on record, or said sender's fingerprint key does not match that of said record, or said sender's anti-spam points are insufficient, then said system: i. denying authentication; ii. acknowledging said recipient's email server of denied authentication, and requesting said email server or email client to hold said sender's email for further discretion; iii. sending a registration request to said sender; iv. approving said email if said sender registers within a predetermined period of time; v. deleting said email or adding a flag to said email if said sender fails to register within the predetermined period of time (Col. 3 lines 13-49); and

e) said system validating authentication and making said email available for delivery, optionally inserting text messages and/or hyperlinks to the body of said email, and deducting appropriate quantities and appropriate types of anti-spam points from said sender's record (Col 3 lines 44-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of verification of sender data and the subsequent rectification with the prior art of

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Kamakura. One of ordinary skill in the art would have done so for the purpose of informing a sender of a deficiency in their send request and directing the sender to properly perform payment or other verification tasks (Col. 3 lines 13-28).

e. As per claim 13, Kamakura and Moskowitz teach the invention substantially as claimed above. However, Kamakura fails to explicitly disclose wherein said registration request is issued from the recipient's email server or email client.

Moskowitz teaches wherein said registration request is issued from the recipient's email server or email client (Col. 3 lines 12-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of a recipient's email server or client sending a registration request to an email sender. One of ordinary skill in the art would have done so for the purpose of informing a sender of a deficiency and permitting the sender to submit payment or other verification (Col 3 lines 13-28).

f. As per claim 14, Kamakura and Moskowitz teach the invention substantially as claimed above. Additionally, Kamakura discloses wherein step v. is replaced with "adding a flag to said email and/or making said email available to said recipient for deleting, downloading, filtering and/or allowing exploitation of sender's email by said recipient." (Col. 6 lines 48-67).

g. As per claim 15, Kamakura and Moskowitz teach the invention substantially as claimed above. Kamakura additionally discloses wherein said sender elects to omit sending said fingerprint key (Col. 6 lines 33-43). However, the prior art of Kamakura fails to explicitly disclose while said system requests for registration, the

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request provides a link to a web address where said sender inputs his or her fingerprint key.

Moskowitz teaches while said system requests for registration, the request provides a link to a web address where said sender inputs his or her fingerprint key (Col. 3 lines 12-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of directing a sender to a web address for input with the prior art of Kamakura. One of ordinary skill in the art would have done so for the purpose of informing a sender of a deficiency and directing the sender to a web address in order to submit payment or other verification (Col 3 lines 13-28).

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GRANT FORD whose telephone number is (571)272-8630. The examiner can normally be reached on 8-5:30 Mon-Thurs alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharra can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/
Supervisory Patent Examiner, Art
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Examiner, Art Unit 2441